

CORRESPONDENCE COVER SHEET

U.S. Patent Application Serial Number 09/991,379

To: Examiner Sieg Chencinski, Art unit 3695

E-Mail: sieg.chencinski@uspto.gov

From: Matthew Sarles - Reg. No. 58,696

Townsend and Townsend and Crew, Attorneys-of-Record

Direct Phone Line : 303-607-3296

mtsarles@townsend.com

Interview Date/Time: Thursday October 21, 2010, 1:30pm EDT

--- Thank you for scheduling this interview. I will give you a call at 571-272-6792 at the above time. ---

USPTO Form 413 is attached.

Topics for discussion follow:

Application History:

May 19, 2008 – Applicant files Notice of Appeal

August 11, 2008 through November 3, 2008 – Applicant and Examiner file briefs

April 30, 2010 – BPAI affirms the Examiner In-Part:

- * BPAI affirms rejections of claims 1-12 and 14-20
- * BPAI overturns rejection of claim 13

June 30 ,2010 – Applicant files amendment canceling claim 13 and incorporating its recitations into all independent claims of the application (claims 1, 10, and 17)

August 16, 2010 – Office issues non-final office action rejecting independent claims 1, 10, and 17 on the same grounds which were overturned by the BPAI with respect to claim 13

Portion of BPAI decision overturning rejection of claim 13:

From page 10 of the BPAI decision:

Dependent Claim 13

We are persuaded that the Examiner erred in asserting that a combination of Wilf, Daniels, Matyas, and AAPA renders obvious “wherein the receiving transaction information step triggers the opening a pop-up window step,” as recited in dependent claim 13 (App. Br. 8; Reply Br. 3). The Examiner asserts that “Wilf, Daniels, Matyas and AAPA disclose a method wherein the receiving transaction information step triggers the opening of a pop-up window step (This triggering step is implicit to the way a pop-up window or automatically opening window is implicitly designed to work)” (Exam’r’s Ans. 7). Even if the cited references generally disclose the nature of how pop-up windows are triggered, the Examiner has not met the initial burden of showing how the references disclose that receiving transaction information triggers the opening as recited in dependent claim 13. *In re Oetiker*, 977 F.2d at 1445.

Portion of Claim 1 at issue (similarly recited by claims 10 and 17)(emphasis added):

“at a funds transaction server, receiving transaction information from the vendor site, wherein the transaction information comprises a transaction amount;

opening a pop-up window for the customer, **wherein the receiving transaction information step triggers the opening a pop-up window step**”

Discussion:

- The language of the BPAI reversed a rejection of the contents of claim 13, now included in all independent claims, where the rejections was based on Wilf, Daniels, Matyas, and AAPA
- The new non-final Office Action maintains the basis of rejection overturned by the BPAI
- The BPAI decision clearly states that “the Examiner has not met the initial burden of showing how the references disclose that receiving transaction information triggers the opening [a pop-up window step]”
- Examining the newly cited portions of Matyas (see pages 4 & 5 of Office Action):

The plug-in content in the HTML page (to be viewed) references a Multipurpose Internet Mail Extensions (MIME) file type that must be supported by a specific plug-in, in order for the content to be displayed/viewed. When the Netscape Navigator (browser), or any compatible browser, encounters the <EMBED> tag, the browser verifies that the required plug-in, needed to display the content corresponding to that <EMBED> tag, has been installed. If so, then the browser will invoke the plug-in to view/display the MIME content corresponding to the EMBED tag. Otherwise, the Netscape Navigator (browser), opens a pop-up window, which will allow the user to download and install the required plug-in. Once the plug-in has been installed, it can be reused repeatedly without downloading it each time.

This portion of Matyas discloses opening a pop-up window if a plug-in is missing, not upon receipt of transaction information, much less receipt of transaction information at a funds transaction server from a vendor site, much less where that transaction information includes a

transaction amount, as is all recited by claim 1. Therefore, this portion of Matyas does not teach or suggest the recitations of claim 1.

Using the information contained in the <EMBED> tag, the MiniPay plug-in displays a pop-up window with all the necessary information to permit the user to initiate a MiniPay payment order. An understanding of these steps is not important to the present invention.

This portion of Matyas, in conjunction with the previous portion, discloses opening a pop-up window upon encountering of an <EMBED> tag, , not upon receipt of transaction information, much less receipt of transaction information at a funds transaction server from a vendor site, much less where that transaction information includes a transaction amount, as is all recited by claim 1. Therefore, this portion of Matyas does not teach or suggest the recitations of claim 1.

- Examining the newly cited portions of Daniels (see page 5 of Office Action):

The next functional module is display support module 357. Display support module 357 provides visual feedback devices which enable a user client 30 to better utilize electronic forms application 35. Electronic forms application 35 may include any of a number of visual feedback devices, for example, pop-up windows and grid displays. Pop-up windows are windows which open or "pop-up" when a display button is actuated, for example, button 46 on GUI 351 shown in FIG. 4a. The pop-up window opened when button 46 is actuated displays a calendar, for example, to assist the user in entering information in the requested ship date box of the electronic purchase order. Further, in keeping with the instant editing functionality of electronic forms application 35, the calendar displayed in response to actuating

button 46 may display days on which shipment is available differently from days on which shipment is not available. For example, if a shipper does not ship on Saturdays and Sundays, those days may be blacked out on the calendar displayed. Pop-up windows are also useful for other controls, for example, time controls. Time control windows operate similarly to calendar windows by displaying, for example a clock face with the present time. Further, time control windows may operate in conjunction with calendar windows. For example, the hours of operation of a particular business on a particular date (chosen through use of a calendar window) may be displayed on a clock face differently than the hours which that particular business is closed on that particular day.

This portion of Daniels discloses that electronic forms can include pop-up windows, that pop-up windows may be actuated via a button on a GUI, and that a pop-up window could be made to display a clock or calendar. Nothing in this portion of Daniels discusses opening a pop-up window upon receipt of transaction information, much less receipt of transaction information at a funds transaction server from a vendor site, much less where that transaction information includes a transaction amount, as is all recited by claim 1. Therefore, this portion of Daniels does not teach or suggest the recitations of claim 1.

- The Office Action, on page 6, appears to recognize the gulf of difference between the mere existence of pop-up windows in the art and triggering a pop-up window as recited by the instant claims. To this end the Office Action states that the existence of pop-up windows at the time of application,

“means that the ordinary practitioner at the time of Applicant’s invention would have known that pop-windows could be used with all kinds of triggers. This would surely include the circumstance of ‘opening a pop-up window for the customer;

wherein the receiving transaction information step triggers the opening the equivalent of a pop-up-window step'. Common sense would have told the practitioner that this notoriously well known device or technique would make for an efficient and effective automated method for conveying transaction information to a customer.”

- Essentially in the above portion of the Office Action, Official Notice is being taken of the difference, absent in the art, between the mere existence of pop-up windows, and “wherein the receiving transaction information step triggers the opening a pop-up window step” as recited by the claims.
- Applicant disagrees and traverses such taking of Official Notice, and believes that the BPAI’s statement that “the Examiner has not met the burden initial burden of showing how the references disclose that receiving transaction information triggers the opening [a pop-up window step]” explicitly states the BPAI’s view on the matter: that the references must show the technical difference recited by the claim, that being “wherein the receiving transaction information step triggers the opening a pop-up window step”

Summary:

- Applicant believes claims 1, 10, and 17 are allowable over the cited references for the above reasons, and respectfully requests issuance of a formal Notice of Allowance